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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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08/626,461 04/02/96 SUNDRAM

219/026
EXAMINER

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A3M1/1126

ART UNIT PAPER NUMBER

1302 13

1302
DATE MAILED:

11/26/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 10-30-97

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-47 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☒ Claim(s) 34 is/are allowed.
☒ Claim(s) 1-12, 15-17, 20-47 is/are rejected.
☒ Claim(s) 13, 14, 18, 19 is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

Art Unit:

The declaration and request for reconsideration have been considered but are not sufficient to overcome the rejection. The terminal disclaimer has been entered and the final rejection in this case has been withdrawn.

The amendment filed May 7, 1997 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Applicant has argues that AHA was fully defined in the manuscript of the prior application but his manuscript was not a part of the specification. It is not seen that the present application inherently follows the AHA step 1 diet of the claims because the saturated fat content used is too high. Applicants arguments concerning the AHA diet are not persuasive because in the prior patent the term AHA was used in connection with a fat blend with no particular reference to what step was intended. Further AHA is not defined. The manuscript which is a part of the parent application is different from the original patent application. No reference is made in the parent application to this manuscript and it is not a part of the appendix in the case. Thus the fact that applicant may or may not be recommending a particular amount of fat in the diet according to AHA recommendations is not a part of the invention. Further the amount of saturated versus unsaturated fat in the present application does not appear to fall within that of the AHA step 1 blend. Additionally applicant suggests at page 28 that his diet is better than AHA.

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Also there is not suggestion in the original case as to genetic engineering of plants as shown in claim 30.

Claims 41 to 45 and 35 to 38 include new matter and are not a part of the specification as originally filed because there is not prepared food product in the specification.

Applicant is required to cancel the new matter in the response to this Office action.

Claims 1-6, 23-26, 30-33, 35-38, 40-45 and 47 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are rejected for the same reason as set for in the objection to the specification.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-12, 15-17 and 20-28 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-29 of prior U.S. Patent No. 5,578,332. This is a double patenting rejection.

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Claims 10-12, 20-22 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims contain improper markush groups. An amendment to the claims changing "including" to -consisting of- would overcome the rejection.

Claims 13, 14, 18 and 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 29 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It is not seen that this claim further limits the claims from which it depends because the claims calls for no positive step or result. Cancellation is suggested.

Claim 34 is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Paden whose telephone number is (703) 308-3294. The examiner can normally be reached on Monday to Friday from 7:30 to 4:00.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lacey, can be reached on (703) 308-3535. The fax phone number for this Group is (703) 305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0651.


CAROLYN PADEN 11-17-97
PRIMARY EXAMINER
ART UNIT 132